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10/563,874	06/19/2006	Michael Lobb	Q92368	1951
23373 7590 05/27/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER CAMPBELL, KELLIE L				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 05/27/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/563,874

Applicant(s)

LOBB ET AL.

Examiner

KELLIE CAMPBELL

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
4a) Of the above claim(s) 1-22 and 53-129 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 23-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

1. The following is first, non-final Office action on the merits. **Claims 1-129** are pending and subject to a restriction requirement. **Claims are 1-22 and 53-129 are withdrawn. Claims 23-52 are elected and examined below.**

Election/Restrictions

2. Applicant's election without traverse of Claims 23-52 in the reply filed on April 29, 2010 is acknowledged.

Priority

3. Applicant's claim for foreign priority (10/563874, filed June 19, 2006 is a national stage entry of PCT/GB04/02846, International Filing Date: July 01, 2004 which claims foreign priority to 0316079.3, filed July 09, 2003) under 35 U.S.C. 119(a)-(d) is acknowledged. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawing

4. The drawings were received on January 1, 2006. These drawings are accepted by Examiner

Specification

5. The abstract of the disclosure is objected to because of instances of non-standard American English-for example, "utilising". Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: instances of non-standard American English-for example, "utilising".

Appropriate correction is required.

Claim Objections

7. Claim 30 and 45 are objected to because of the following informalities: "utilising" should be "utilizing". Appropriate correction is required.

8. Claims 23-37 are objected to because of the following informalities: the method steps are not positively recited. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 38-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

11. As per Claims 38-52, claim element "means for" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

There is insufficient disclosure of the corresponding structure for performing the claimed function as Applicant only discloses that the method of the instant application can be performed by a "computer system". Therefore, Examiner will not interpret Claims 38-52 under 35 U.S.C. 112, sixth paragraph.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claims 23-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

14. **As per Claims 23 and 38**, they are directed to a process comprising the method step of "processing". In order for a process to be considered statutory under 35 U.S.C. §101, the claimed process must satisfy the **"machine or transformation test"**; that is the process must either: (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing. In re Bilski, 545 F. 3d 943, 88USPQ2d 1385 (Fed. Cir. 2008). When neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. §101 and is non-statutory subject matter. The method steps of Claims 23 and 38 (see 112 rejection above) are not tied to a machine or apparatus and do not involve transforming an article into a different state or thing. Thus, Applicant's claim is not drawn to patent-eligible subject matter because it fails the **"machine or transformation test"**. Therefore, Claims 23 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. **As per Claims 22-37 and 39-52**, they depend either directly or indirectly on Claim 1 and do not cure the deficiencies set forth above. Therefore, Claims 2-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. **Claims 23-36 and 38-51 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0140730 to Linsey et al. (hereinafter Linsey).**

18. **As per Claims 23 and 38**, Linsey discloses a method (and related computer system) of processing a workflow comprising a plurality of tasks, in which completion of at least one task is notified by instant messaging (see at least Figures 12-13 and related text; ¶225-234, chat; ¶38, A method and system is provided for managing collaboration space by providing users of the collaboration space a report of events and happenings throughout a place that are of current interest, including scheduled events or tasks that are current, and what has been recently changed; and providing the report to a user interface selectively upon user request or in accordance with a schedule; ¶41, FIG. 1 is a schematic representation of a typical server/client system implementing the collaboration space of the preferred embodiments of the invention.).

19. **As per Claims 24 and 39**, Linsey discloses a method (and related computer system) according to claim 23 wherein the notification is to an owner of a subsequent task (see at least Figures 12-13 and related text;).

20. **As per Claims 25 and 40**, Linsey discloses a method (and related computer system) according to claim 23 or claim 24 further comprising storing an identity associated with said workflow in a database (§209, Referring to FIG. 11, each room in collaboration space is implemented as a database 310-312. A Notes view 314-316 and folder 318-320 is associated with each such database. Using notes security, each person looking at view sees what is authorized to see.).

21. **As per Claims 26 and 41**, Linsey discloses a method according to claim 25 wherein said database stores the identity of a plurality of workflows (§209, Referring to FIG. 11, each room in collaboration space is implemented as a database 310-312. A Notes view 314-316 and folder 318-320 is associated with each such database. Using notes security, each person looking at view sees what is authorized to see.).

22. **As per Claims 27 and 42**, Linsey discloses a method according to claim 25 further comprising the step of storing a status associated with the current state of the workflow (see at least Figures 12-13 and related text).

23. **As per Claim 28 and 43**, Linsey discloses a method according to claim 27 wherein the status is updated responsive to the notification by instant messaging of a task associated with the workflow (§237, It is a further advantage the invention that there is provided a system and method for presenting users of collaboration space knowledge of events and happenings throughout a place that are of current interest, including scheduled events or tasks that are current, and what has been recently changed.; §76, Referring to FIG. 12, a typical QuickPlace user interface 370 includes a sidebar (TOC) 372, page title 374, author and modified field 376, actions bar 378, logo

380, path 382, page content 400, and actions buttons, such as quick search 384, advanced search 386, whatsnew 388, chat 390, notify 392, print 394, tutorial 396 and help 398.).

24. **As per Claim 29 and 44**, Linsey discloses a method according to claim 28 wherein the updating of the status is notified by instant messaging (see Figure 12 and related text; ¶207, A what's new display, in accordance with this embodiment of the invention, extends to all elements, such as pages, tasks, events, folders, rooms, members, groups, today's events & tasks due, and email received.).

25. **As per Claims 30 and 45**, Linsey discloses a method according to claim 23, in which completion of at least one task is notified by a plurality of messages utilising instant messaging (see Figure 12 and related text; ¶207, A what's new display, in accordance with this embodiment of the invention, extends to all elements, such as pages, tasks, events, folders, rooms, members, groups, today's events & tasks due, and email received.).

26. **As per Claims 31 and 46**, Linsey discloses a method according to claim 30 wherein there is associated a plurality of users with said workflow, each message being associated with one of said users (see Figure 12 and related text; ¶207, A what's new display, in accordance with this embodiment of the invention, extends to all elements, such as pages, tasks, events, folders, rooms, members, groups, today's events & tasks due, and email received.).

27. **As per Claims 32 and 47**, Linsey discloses a method according to claim 31 wherein each task is completed by one of said users (see Figures 12-13 and related

text; ¶207, A what's new display, in accordance with this embodiment of the invention, extends to all elements, such as pages, tasks, events, folders, rooms, members, groups, today's events & tasks due, and email received.)..

28. **As per Claims 33 and 48**, Linsey discloses a method according to claim 32 wherein at least one task is determined by a user (see Figures 12-13 and related text).

29. **As per Claim 34 and 49**, Linsey discloses a method according to claim 33 wherein at least one task is the preparation of a document, and at least one further task is a preparation of a comment on a document (see Figure 12 and related text; ¶56, Open storage 130 is storage where a document can be communicated, such that external applications 142 may manipulate it. QuickPlaces, pages, folders, can be created and changed, and data 148 can be imported and exported, using agents in Java 144 or LotusScript 146.).

30. **As per Claim 35 and 50**, Linsey discloses a method according to claim 34 wherein the workflow is the preparation of a report (see Figure 12 and related text).

31. **As per Claims 36 and 51**, Linsey discloses a method according to claim 23 further comprising determining the presence of a recipient of said instant messaging (¶231, To start a chat session with all the QuickPlace members who currently have the QuickPlace Team Chat window open enter and send the message, and it will be sent to all the members listed under "Who is here?" and displayed in the Transcript area.; see at least Figures 12-13 and related text; ¶230, To start a chat session with two or more QuickPlace members, a member first invites those other members to participate in the session. To create an invitation for two or more members and then start the chat

session, the member clicks "chat" 390 in the "Tools" sidebar. In the "Who is here?" section 542 of the QuickPlace Team Chat window that appears on the screen, the member presses and holds the shift or Ctrl key while clicking the names of the members with to chat. Then, a single-option menu may be selected in which to create an invitation for the chat session entering the subject of the chat in the Topic box, entering the text of invitation in the Message text box, optionally selecting "Secure messages" to prevent anyone outside the QuickPlace from intercepting and reading the messages. The member enters and sends messages and receives replies as above.).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. **Claims 37 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linsey in further view of U.S. 2004/0230466 to Davis et al. (hereinafter Davis).**
34. **As per Claims 37 and 52**, Linsey does not expressly disclose a method according to claim 36, wherein if said recipient is not present, the instant messaging is directed to a nominated delegate.

However, Davis teaches setting personal rules for the handling of instant messages (§107, Personal Business Rules are business rules that apply only to an

individual user of the System. The system will allow an individual to create rules that can only be invoked for the conditions that the user has set for himself or herself.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Linsey with the teachings of Davis to include wherein if said recipient is not present, the instant messaging is directed to a nominated delegate in order to ensure that time sensitive messages can be addressed even when the intended recipient is not available.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kellie Campbell whose telephone number is (571) 270-5495. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5 pm est. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KC

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691